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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/757,424	01/11/2001	David Bain	59BAI002.C11	1307
21919	7590	09/02/2005	EXAMINER	
MEREK, BLACKMON & VOORHEES, LLC 673 S. WASHINGTON ST. ALEXANDRIA, VA 22314			MEINECKE DIAZ, SUSANNA M	
			ART UNIT	PAPER NUMBER
			3623	

DATE MAILED: 09/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/757,424

Applicant(s)

BAIN, DAVID

Examiner

Susanna M. Diaz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 1-10 and 17-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 February 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. This final Office action is responsive to Applicant's election filed June 20, 2005. Applicant elects Species II with traverse. Applicant added "claims 17-21 that are dependent from claim 11 and recite limitations to a combined species I and II." Applicant further submits, "This would appear to make claim 11 generic to species II and the combination of species I and II (as recited in claims 17-21)." (Page 2 of Applicant's response) However, the specification discloses both species as distinct and separately patentable embodiments of a commission system. The specification does not disclose an express integration of the two species. In other words, performance of either species does not affect the functionality of the other. Similarly, claims 17-21 recite "a commission" (as opposed to "said commission") and are not tied into the commission processor of claim 11; therefore, claim 11 is not generic to both species. Furthermore, claims 11-16 are clearly directed toward Species II due to their emphasis on providing credits to users in the form of votes on a list of issues. Claims 17-21 are directed toward Species I since they emphasize the payment of commissions in the form of monetary compensation paid out to a designated site. In Species I, the designated site is the direct recipient of monetary compensation, while in Species II, the user making a purchase is the direct recipient of an incentive in the form of a vote(s).

Furthermore, Applicant fails to traverse on the grounds that the species are not patentably distinct. The Examiner submits that Species I and II are not obvious variants of one another and they are mutually exclusive; therefore, the restriction requirement is

maintained as proper. Consequently, claims 1-10 and 17-21 are withdrawn from consideration for being directed toward non-elected Species I.

Claims 11-16 are presented for examination.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 11-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 11 recites the limitation "said commission" in line 4. There is insufficient antecedent basis for this limitation in the claim.

Step (b) of claim 11 recites "the user choosing one issue to vote on, and selecting a candidate answer for said one issue." Step (a) recites "a list of issues to vote on." Step (b) does not tie the selected issue to the "list of issues to vote on" from step (a). It is not clear whether the user necessarily selects an issue from the list recited in step (a) or not since reference is not made to "said list of issues."

Claims 12-16 are dependent from claim 11 and therefore inherit the same rejections under § 112.

Appropriate correction is required.

***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claim 11 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts. Mere intended or nominal use of a component, albeit within the technological arts, does not confer statutory subject matter to an otherwise abstract idea if the component does not apply, involve, use, or advance the underlying process.

While claim 11 produces a useful, concrete, and tangible result, the extent of integration of technology is unclear, especially since dependent claims 12-16 expressly recite that the steps of tracking the on-line purchase and tabulating votes are performed by the commission processor. This leads one to question whether or not the core steps

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of tracking and crediting votes may be performed manually in claim 11. Also, while the user makes a purchase on-line via a website, the extent of processing performed by the website is unclear. For example, if the website merely transmits and receives data without performing any real processing of the data (e.g., for analysis or calculation purposes), then recitation of the website amounts to nothing more than a nominal recitation of technology, thereby rendering claim 11 non-statutory. Please note that claims 12-16 are deemed to be statutory because they recite core steps of the invention as being performed by a computer processor.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 11-16 are rejected under 35 U.S.C. 102(e) as being anticipated by  
Blumberg (U.S. Patent No. 6,240,415).

Blumberg discloses a method for voting through an on-line purchase comprising the steps of:

[Claim 11] a. a user connecting to a website of a commission processor, said commission including a list of associated vendors and a list of issues to vote on (Figs. 5a, 5b; col. 3, lines 26-67; col. 6, lines 37-41; col. 10, lines 20-65 -- Fans can select a league/team, i.e., a vendor, as well as a list of issues of interest);

b. the user choosing one issue to vote on, and selecting a candidate answer for said one issue (col. 3, lines 26-67; col. 10, lines 20-65);

c. the user choosing one vendor from said list of associated vendors to purchase a good or service on-line (col. 10, lines 20-40 -- Each team sets forth its respective voting rules. Fans can purchase the right to vote on team issues through the IPIE, which is an example of a good or service purchased on-line);

d. the user making an on-line purchase with said one vendor for the good or service (col. 10, lines 20-40 -- Each team sets forth its respective voting rules. Fans can purchase the right to vote on team issues through the IPIE, which is an example of a good or service purchased on-line);

e. tracking the on-line purchase (col. 3, lines 26-67; col. 10, lines 20-65 -- Voting rights and tabulations are tracked in order to put the results of the votes into action in the form of a team management strategy/decision);

f. crediting votes to said selected candidate answer based on the on-line purchase (col. 3, lines 26-67; col. 10, lines 20-65 -- Voting rights and tabulations are tracked in order to put the results of the votes into action in the form of a team management strategy/decision. The fans can purchase votes);

[Claim 12] wherein said commission processor tracks the on-line purchase (col. 3, lines 26-67; col. 10, lines 20-65 -- Voting rights and tabulations are tracked by the IPIE in order to put the results of the votes into action in the form of a team management strategy/decision);

[Claim 13] wherein said commission processor tabulates votes credited to issues and candidates (col. 3, lines 26-67; col. 10, lines 20-65 -- Voting rights and tabulations are tracked by the IPIE in order to put the results of the votes into action in the form of a team management strategy/decision);

[Claim 14] wherein one vote is tabulated for each dollar spent in the on-line purchase (col. 10, lines 30-32 -- Each vote may be sold for the price of one dollar);

[Claim 15] wherein one vote is tabulated for each on-line purchase (col. 10, lines 30-32 -- Each vote may be sold for the price of one dollar through an on-line purchase);

[Claim 16] wherein the number of votes tabulated is determined at least in part by the monetary value of the on-line purchase (col. 10, lines 30-32 -- Each vote may be sold for the price of one dollar).

### ***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).



A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (571) 272-6733. The examiner can normally be reached on Monday-Friday, 10 am - 6 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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*Susanna Diaz*  
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Primary Examiner  
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August 31, 2005